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09/686,346

10/10/2000

Melanie H. Cobb

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01/17/2003

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 01/17/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/686,346

Applicant(s)

Cobb et al.

Examiner

Maryam Monshipouri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-48 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 28-48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Applicant's response to restriction required filed 11/4/2002 (paper #12) is acknowledged. Applicant elected Group IVB invention directed to claims 28-48 in part, drawn to methods of screening modulators of MAP kinase signal transduction through modulating TAO2 kinase with traverse. Claims 28-48 (in part ) drawn to methods of use of TAO1 and ceTAO are hereby withdraw as drawn to non-elected invention.

In traversal of restriction requirement applicant argues the following: that the requirement sets forth a proper species election but does not set forth a proper restriction requirement. This is because according to applicant, claims 28-29, comprise generic claims which recite a "TAO polypeptide". Claim 30 which depends from either of claims 28 or 29 sets forth that "said TAO is selected from group consisting of TAO1, TAO2, or ceTAO.

Accordingly, restriction of the generic claims 28-29 is improper under applicable law and restriction of the proper Markush claim is likewise improper.

Applicant then goes on to explain how the prosecution of a Markush type claim should be conducted etc. and concludes that in view of no showing that any of Markush style claims presented are improper, restriction as stated in the previous office action is improper and should be withdrawn.

These arguments were fully considered but were found **unpersuasive** because of the following reason: firstly, following applicant's admittance that claims 28-30 are Markush claims, said claims are objected under 37 CFR section 1.75(d)(1) as being improper form because the claims state an improper Markush group. Compounds included within a Markush group must"(1)

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**share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.**" The structure of the TAO polypeptides in Markush Group of claim 30 do not share a common utility, and the specification does not teach that the polypeptides share a substantial structural feature disclosed as being essential to that utility.

Therefore, in view of the fact that claims 28-30 are improper Markush claims said claims were , in contrast to applicant's view, **properly** restricted (in part) as drawn to three independent and distinct inventions. Further, even though the examiner is grateful to the applicant for explaining how prosecution of Markush claims should be conducted said comments are currently not relevant to pending claims.

In conclusion, given the fact that no showing of why TAO1-2 and ceTAO are proper species of supposedly Markush claims 28-30 are provided, restriction according to previous office action is maintained and is hereby made **final**.

Upon further review of previous restriction letter, further restriction is deemed necessary as explained below:

Group **IVb(1)**, drawn to methods of screening modulators of MAP kinase signal transduction through comprising using TAO2 kinase in order to activate MEK1.

Group **IVb(2)**, drawn to methods of screening modulators of MAP kinase signal transduction through comprising using TAO2 kinase in order to activate MEK2.

Group **IVb(3)**, drawn to methods of screening modulators of MAP kinase signal transduction through comprising using TAO2 kinase in order to activate MEK3.

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Group **IVb(4)**, drawn to methods of screening modulators of MAP kinase signal transduction through comprising using TAO2 kinase in order to activate MEK4.

Group **IVb(5)**, drawn to methods of screening modulators of MAP kinase signal transduction through comprising using TAO2 kinase in order to activate MEK5.

The inventions of Group IVb(1)-(5) are each patentably distinct each over the other because each method has different steps and different end-points and each method uses an independent and distinct MEK.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

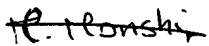
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308-1083.

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The Examiner can normally be reached daily from 8:30 A.M. to 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Maryam Monshipouri, Ph.D.

Primary Examiner